

REMARKS

Upon entry of the instant amendment, claims 1, 2 and 4-9 will remain pending in the above-identified application and stand ready for further action on the merits.

In this Amendment, claim 1 has been amended to recite a limitation previously recited in claim 3 (*and claim 3 has been canceled to prevent a redundancy with amended claim*).

Support for the amendment to claim 1 also occurs at page 4, lines 15-16 of the instant specification, which recites in part "*The resin used in the present invention preferably has an acid value of 5 to 70 KOH-mg/g....*" Claim 9 has been also amended herein to remove its dependency upon canceled claim 3.

Accordingly, the present amendments to the claims do not introduce new matter into the application as originally filed. As such entry of the instant amendment and favorable action on the merits is earnestly solicited at present.

Claim Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-7 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nakajima et al. (WO 02/031010) (*with EP 1,270,624 A1 being relied on by the USPTO as an English translation of WO 02/031010*).

Claim 8 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative under 35 U.S.C. § 103(a) as obvious over Nakajima et al. (WO 02/031010) with additional evidence provided by www.mrinkjet.com/inkreport.htm (*with EP 1,270,624 A1 being relied on by the USPTO as an English translation of WO 02/031010*).

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;
- (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success
- (f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions Over the Cited Art

The USPTO alleges that **Nakajima et al. (WO ‘010)** teach a pigment dispersion comprising water-insoluble pigments whose surfaces are coated with a polyoxyalkylene-containing resin. However, **Nakajima et al. (WO ‘010)** prepares such a dispersion by simply

mixing pigments and the resin, and does not describe or suggest that the surfaces of the pigments are coated with the resin.

In the present invention, an aqueous dispersion containing a water-insoluble solid is prepared by mixing an organic phase containing a water-insoluble solid and a resin having a polyether structure with an aqueous phase using the self-dispersing property of the resin, i.e., the emulsification of the resin.

Nakajima et al. (WO '010) do not teach the utilization of the self-dispersing property of the resin.

As described at page 3, line 27 to page 4, line 26 of the present specification, since an aqueous dispersion is prepared by using the self-dispersing property of the resin, the resin should have a polyether structure which is compatible with the surfaces of the solid particles and also with water. To this end, the resin having the polyether structure used according to the present invention should have a specific acid value.

The USPTO alleges that **Nakajima et al. (WO '010)** disclose a resin having an acid value of 5-150 [0055] (*see Item 7 in page 3 of the Office Action*). Paragraph [0055] of the WO '010 publication describes the acid value of an acrylic resin which is an example of other pigment dispersing resins which are used where necessary. This acid value is not an acid value of a copolymer having polyoxyalkylene chain (polyether structure).

Since **Nakajima et al. (WO '010)** do not utilize a self-dispersing property of a resin, **Nakajima et al. (WO '010)** do not suggest that the resin having the polyether structure should have the same acid value as that of the acrylic resin.

Accordingly, the present invention would not have been anticipated by, or rendered obvious by Nakajima WO '010, since the same reference fails to teach or provide for each of the limitations recited in the pending claims, and fails to provide those of ordinary skill in the art with any reason or rationale that would allow them to arrive at the instant invention as claimed.

Any contentions of the USPTO to the contrary must be reconsidered at present.

Conclusion

In view of the amendment and remarks presented herein, the USPTO is respectfully requested to issue a Notice of Allowance in the matter of the instant application, clearly indicating that claims 1-2 and 4-9 currently under consideration are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/554,635
Amendment dated November 13, 2008
Reply to Office Action of August 13, 2008

Docket No.: 0020-5434PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: November 13, 2008

Respectfully submitted,

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